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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,243	02/10/2005	Boris Mayer	30882/DP022	4628
4743 7590 12/05/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER ROBINSON BOYCE, AKIBA K	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 12/05/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,243

Applicant(s)

MAYER ET AL.

Examiner

AKIBA K. ROBINSON BOYCE

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Due to communications file 8/22/08, the following is a non-final office action.

Claims 12-16 are pending in this application and have been examined on the merits.

The previous rejection has been withdrawn, and claims 12-16 are rejected as follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman, Jr. (US 4,106,060), and further in view of Moskowitz et al (US 7,280,982).

As per claim 12, Chapman, Jr. discloses:

A method for conveying mailpieces using an electronic parcel compartment system, wherein when a mailpiece is deposited, (Col. 2, lines 58-61, document entered into slot and wrapped to be read by scanner), the electronic parcel compartment system records and/or generates identification information that identifies the mailpiece, (Col. 3, lines 29-39, scanner reads document and converts to electronic form), and, during subsequent processing steps of the mailpieces, the identification information is recorded and/or evaluated in a data processing unit that stores transport data, and the identification information is stored in the electronic parcel compartment system and/or in

a central data processing unit, (Col. 3, lines 39-40, electronic form passed to a buffer to be stored for later transmission).

Chapman, Jr. does not specifically disclose the following, however does disclose a system for processing a mailed document electronically as shown above.

However, Moskowitz et al discloses:

wherein the identification information contains monetary information, in the area of the electronic parcel compartment system, (Col. 2, lines 25-28, detecting an address signal on the incoming signal or call, and determining the fee to be charged to that incoming message or call)

the method comprising the steps of carrying out a payment checking procedure to confirm the presence of at least one of a monetary amount and monetary information in a predefinable amount, (Col. 2, lines 29-32, determining whether payment has been made, or payment can be made upon fee determination)

and activating an access possibility for depositing a mailpiece, if the payment checking procedure has confirmed the presence of at least one of said monetary amount and said monetary information, and relating the size of the compartment that opens directly to a set of numbers of the recorded identification information and opening a compartment of the appropriate size for a set of numbers of a certain price class, (Col. 5, lines 23-49, shows fee depends on type/size.

Moskowitz et al discloses the above limitations in an analogous art for the purpose of showing that an appropriate fee must be determined based on an identification, and once the appropriate fee is collected, the mail is sent to the mailbox

which suggests that the mailbox would be of an appropriate size since the appropriate fee for sending the mail to the mailbox would indicate a certain type or size.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose the above limitations with the motivation of allowing the mail of a specific type/size to fit inside of the mailbox.

As per claim 13, Chapman, Jr. discloses:

comprising recording the depositing of the mailpiece into the electronic parcel compartment system in a data processing unit that stores transport data, (Col. 3, lines 39-40, electronic form passed to a buffer to be stored for later transmission).

As per claim 16, Chapman, Jr. discloses:

comprising recording the identification code when the mailpiece is deposited and when the mailpiece is removed from the parcel compartment system by a deliverer, (Col. 3, lines 29-39, once document is entered into slot, scanner reads document and converts to electronic form, and Col. 3, lines 39-40, electronic form passed to a buffer to be stored for later transmission

4. Claims 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman, Jr. (US 4,106,060), and further in view of Moskowitz et al (US 7,280,982), and further in view of Lieberman et al (US 2003/0057143 A1).

As per claim 14, neither Chapman, Jr., nor Moskowitz et al disclose comprising the data processing unit that stores transport data sending a digital notification message for picking up the parcel, however, in Col. 6, lines 13-19, Chapman, Jr. discloses a signal indicative of the determination that said electronic address signals and said

information electronic signals are stored in said storage means and wherein said transmitting means includes means for permitting said transmission only when said determination indicating signal has been produced for the mailed document.

However, Lieberman et al discloses a device notifying the recipient that "A package has just been delivered to you." In [0064]. It therefore would be obvious to combine the teachings of Chapman, Jr., Moskowitz et al and Lieberman to disclose comprising the data processing unit that stores transport data sending a digital notification message for picking up the parcel.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose comprising the data processing unit that stores transport data sending a digital notification message for picking up the parcel with the motivation of showing an indication of package delivery.

As per claim 15, neither Chapman, Jr., nor Moskowitz et al disclose wherein at least one of the notification message and the identification information contains information about the transport of the mailpiece, and comprising the setup of effecting the transport of the mailpiece at least partially on the basis of this information, however, in Col. 6, lines 13-19, Chapman, Jr. discloses a signal indicative of the determination that said electronic address signals and said information electronic signals are stored in said storage means and wherein said transmitting means includes means for permitting said transmission only when said determination indicating signal has been produced for the mailed document.

However, Lieberman et al discloses a characteristic that relates to the delivery method of the communication, and the value assigned to characteristic corresponds directly to the delivery service in [0037]. It therefore would be obvious to combine the teachings of Chapman, Jr., Moskowitz et al and Lieberman to disclose wherein at least one of the notification message and the identification information contains information about the transport of the mailpiece, and comprising the setup of effecting the transport of the mailpiece at least partially on the basis of this information.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to disclose wherein at least one of the notification message and the identification information contains information about the transport of the mailpiece, and comprising the setup of effecting the transport of the mailpiece at least partially on the basis of this information with the motivation of providing indicators that show method of delivery.

Response to Arguments

5. Applicant's arguments, see Response to official action, filed 8/22/08, with respect to the rejection(s) of claim(s) 12-16 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chapman, Jr. (US 4,106,060).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.
December 2, 2008

/Akiba K Robinson-Boyce/
Primary Examiner, Art Unit 3628